



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,066	08/05/2003	A. Wesley Prais	102-523 DIV/CON/CIP/CON	1315
32752 7590 04/09/2007 DAVID W. HIGHET VP & CHIEF IP COUNSEL BECTION DICKINSON AND COMPANY 1 BECTON DRIVE MC 110 FRANKLIN LAKES, NJ 07417-1880			EXAMINER DESANTO, MATTHEW F	
			ART UNIT	PAPER NUMBER
			3763	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/635,066

Applicant(s)

PRAIS ET AL.

Examiner

Matthew F. DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 16-20, 33-36, 49-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Baldwin et al. (USPN 3,071,135).

Baldwin et al. discloses a needle having a multi-beveled point, said needle comprising a cannula having a lumen and a central axis therethrough, said multi-beveled point provided at one end of the cannula, said multi-beveled point comprised of a primary bevel, a pair of tip bevels, and a pair of middle bevels, wherein respective of an angle defined between said central axis and a reference plane, each of said primary bevel, said pair of middle bevels, and said pair of tip bevels are provided on said cannula at a respective planar angle, wherein said planar angles of said primary bevel and said pair of middle bevels are substantially equal (figure 1, 2, 3 and entire reference).

3. Claims 1-3, 16-20, 33-36, 49-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson (USPN 2,560,162).

Ferguson discloses a needle having a multi-beveled point, said needle comprising a cannula having a lumen and a central axis therethrough, said multi-beveled point provided at one end of the cannula, said multi-beveled point comprised of a primary bevel, a pair of tip bevels, and a pair of middle bevels, wherein respective of an angle defined between said central axis and a reference plane, each of said primary bevel, said pair of middle bevels, and said pair of tip bevels are provided on said cannula at a respective planar angle, wherein said planar angles of said primary bevel and said pair of middle bevels are substantially equal (figure 1, 2, 3, 4, 6 and entire reference).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin et al. or Ferguson as applied above.

Baldwin or Ferguson fail to explicitly disclose the specific rotational angle or planar angle of each embodiment.

Therefore at the time of the invention it would have been obvious for one of ordinary skill in the art to modify either Baldwin or Ferguson to have the specific angle being chosen for either the planar angle or the rotational angle because of routine experimentation, and further more, it would have taken only routine skill in

the art to modify the teaches of Baldwin or Ferguson to the angle, size and dimension of the claimed invention. Furthermore, there is no specific criticality or unexpected result being derived from the angles chosen, thus making this modification a matter of design choice, and well within the skill of the ordinary artisan, to determine the optimum results through routine experimentation.

6. Claims 53-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin et al. or Ferguson as applied to claims above, and further in view of Burns (US 5,643,219).

Baldwin et al. or Ferguson teach the claimed invention but fail to disclose a needle shield for the needle and attaching the needle to a syringe.

Burns teaches a needle shield (fig. 11) formed of a styrene block thermoplastic (cols. 5 and 6) and having a needle attached to a hub, which is attached to a syringe.

Therefore, given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Baldwin et al. or Ferguson by including Burns's needle shield into his syringe for needle and user's protection. Furthermore, the instant disclosure describes the hardness as being merely preferable, and does not describe it as contributing any unexpected result to the shield. As such, the hardness is deemed matter of design choice (lacking in any criticality), well within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results.

Art Unit: 3763

Terminal Disclaimer

7. The terminal disclaimers filed on 10/10/06 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of USPN 5,752,942 & USPN 6,629,963 has been reviewed and is accepted. The terminal disclaimers have been recorded.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F. DeSanto whose telephone number is 571-272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3763

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Matthew DeSanto
Art Unit 3763
April 2, 2007